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OFFICE OF PETITIONS

HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
NUTLEY NJ 07110

In re Patent of Flohr, et al.	:	
Patent No.: 7,019,001	:	Decision on Request for Reconsideration
Issue Date: March 28, 2006	:	of Patent Term Adjustment
Application No.: 10/691,770	:	and Notice of Intent to Issue
Filing Date: October 23, 2003	:	Certificate of Correction
Attorney Docket No. 21031US1	:	

This is a decision in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION" filed May 15, 2006, which in essence requests that the Patent Term Adjustment for the above-identified patent be set at 183 days.

The request for reconsideration of the patent term adjustment indicated on the patent is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one hundred eighty three (183) days.

The Determination of Patent Term Adjustment under 35 U.S.C. 154(b) mailed with the Notice of Allowance on September 19, 2005 stated the patent term adjustment to date was 183 days. Applicants state that a second Determination of Patent Term Adjustment under 35 U.S.C. 154(b) was forwarded to applicants with the Issue Notification. The second Determination of Patent Term Adjustment under 35 U.S.C. 154(b) stated the patent term adjustment would be 63 days. The application matured into Patent No. 7,019,001 on March 28, 2006. The printed patent shows a revised Patent Term Adjustment of 63 days. The revised adjustment determination was calculated as follows:

The initial determination of PTA of 183 days was reduced by 120 days because applicants filed a "miscellaneous incoming letter" on October 6, 2005, which was filed after the mailing of a Notice of Allowance on September 19, 2005.

The instant request was timely filed within 2 months of the date the patent issued. See 37 CFR 1.705(d).

The request contends that there were no circumstances within this case history that constitute a failure by the Patentees to engage in reasonable efforts to conclude processing or examination of the above-identified application as set forth in 37 CFR § 1.704. In essence, Patentees dispute the sole reduction of record, one for 120 days associated with the filing of a "miscellaneous incoming letter" received in the Office on October 6, 2005. Patentees state that the paper filed with the response to the Notice of Allowance and Allowability was a Statement of the Substance of the Interview, said interview took place on July 19, 2005 with Examiner Shameem; however, the Interview Summary was first mailed to applicants on September 19, 2005.

Patentees' contention is well taken. The OG Notice states that:

... the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

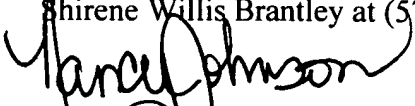
A Statement of Substance of the Interview is not among those examples. Example (6) refers to a Comment on the Examiner's Reasons for Allowance and does not encompass the Statement. Nonetheless, it is concluded that under the circumstances, the Statement of Substance of the Interview should not be considered "a failure to engage in reasonable efforts" to conclude processing or examination of an application and should not result in reduction of the patent term adjustment pursuant to 37 CFR 1.704(c)(10). Thus, it is concluded that the reduction of 120 days of patent term is not warranted.

In view of the facts above, the patent term adjustment indicated on the patent should have been one hundred eighty three (183) days.

Submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by ONE HUNDRED EIGHTY THREE (183) days subject to any disclaimers.

Telephone inquiries regarding this communication should be directed to Petitions Attorney
Shirene Willis Brantley at (571) 272-3230.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,019,001

DATED : March 28, 2006

INVENTOR(S) : Alexander Flohr, et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (63) days

Delete the phrase "by 63 days" and insert – by 183 days--